

REMARKS

Applicant has carefully reviewed the Final Office Action mailed August 24, 2006 and offers the following remarks.

Claims 1-28 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,411,802 B1 to Cardina et al. (hereinafter "Cardina"). Applicant respectfully traverses. For the Patent Office to prove anticipation, each and every element of the reference must be present in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Before addressing the rejections, Applicant provides a brief summary of the present invention and the Cardina reference so that the remarks relating to the references are considered in the proper context. The present invention is designed to facilitate the transition of a mobile terminal from a cordless mode to a cellular mode. That is, a user will have a dual mode mobile terminal. In the first mode, occurring typically when the user is at the user's premises, the mobile terminal will function in the cordless mode by interfacing via a terminal adaptor with the PSTN. Only if the user and the mobile terminal leave the effective zone of the terminal adaptor is the mobile terminal switched into the cellular mode, wherein the mobile terminal interfaces with the PLMN. If the mobile terminal is involved in a call when the mobile terminal moves out of the terminal adaptor zone, the phone call is transitioned from the PSTN to the PLMN.

In contrast, Cardina discloses a wireless telephone backup device that is located on the customer side of the landline service connection that is used to provide backup telephone services to the CPE when there are service interruptions to the landline connection. The wireless backup device forwards incoming landline calls to the wireless unit in the backup device, and may send a message notifying the maintenance center of the service interruption and an alarm to the CPE site notifying the subscriber. Notably, Cardina's wireless unit is used only when a service interruption is detected. The use of the wireless backup device happens before or during call setup, not during a call. In fact, Cardina teaches that when a service interruption occurs to the wireline connection (the only time the backup wireless device is used), the customer cannot use the CPE to receive or send calls (Cardina, col. 11, lines 28-32). Thus, Cardina is not directed to a method for transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network where a temporary directory number is provided during the call to allow a wireless connection to be established with the mobile terminal via the wireless network.

Claims 1 and 15 recite a method for transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network, the method comprising several steps, including providing a temporary directory number “during the call” to allow a wireless connection to be established with the mobile terminal via the wireless network. As set forth above, Cardina does not teach or suggest providing a temporary number “during the call” to allow a wireless connection to be established with the dual mode mobile terminal via the wireless network. There is nothing in Cardina that discusses transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network, or providing a temporary directory number during the call to allow a wireless connection to be established with the mobile terminal via the wireless network.

The Patent Office cites to Cardina at col. 17, lines 13-41 as allegedly teaching the claimed invention. However, the cited portion of Cardina merely states that when the system recognizes that the landline service has been restored, calls are no longer routed to the backup wireless device, but instead are routed to the terminating SSP originally servicing the directory number. This is not equivalent to the claimed invention, which recites a method for transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network, the method comprising several steps, including providing a temporary directory number “during the call” to allow a wireless connection to be established with the mobile terminal via the wireless network.

The Patent Office also attempts to argue that Cardina discloses providing the temporary directory number during the call. The Patent Office goes through a long description of how the MTSO 110 and the HLR 112 work (Final Office Action mailed August 24, 2006, p. 13). The Patent Office then states that the HLR 112 provides the temporary directory number to the MTSO 110 (during the call). *Id.* at p. 13, lines 17-18. The Examiner cites to Cardina at col. 17, line 37 through col. 18, line 30 as support. Applicant has reviewed the cited section and sees nothing to support the allegation that the temporary directory number is provided to the MTSO during the call. In fact, the cited section supports Applicant’s position that the directory number for the backup wireless device is provided before or during call setup, not during a call. The cited section corresponds to Figure 6 of Cardina. Figure 6 makes it clear that the directory number of the backup wireless device is provided before or during call setup, and not during a call. The MTSO 110 receives a message from the wireless device in step 602, gets the directory

number for the wireless device in step 604, registers the wireless device in step 606, enters a database to reference the landline directory number to the wireless device directory number in step 608, and sets a software trigger in step 610 to forward calls to the temporary directory number. Calls are then forwarded to the temporary directory number in step 612. Thus, the directory number of the backup wireless device is provided before calls are set up. It is clear from Figure 6 and the accompanying description that Cardina does not teach providing the temporary directory number during the call. Since Cardina does not teach providing the temporary directory number during the call, Cardina cannot anticipate claims 1 and 15.

Claims 2-14 and 16-28 depend from claims 1 and 15, respectively, and contain all the limitations of their respective independent claims. Claim 2-14 and 16-28 are therefore patentable for at least the same reasons as claims 1 and 15.

Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardina in view of U.S. Patent No. 6,766,170 to Aretz et al. (hereinafter “Aretz”). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

The Patent Office has not supported the stated motivation to combine Cardina and Aretz with actual evidence. The Patent Office indicated that it would have been obvious to combine Cardina and Aretz “in order to switch independently between both network and switch on request by the mobile terminal.” (Final Office Action mailed August 24, 2006, p. 9). The Patent Office then cites to an asserted advantage of the Aretz system (see Aretz, col. 3, lines 55-63). However, the cited advantage of Aretz has nothing to do with the stated motivation of being able to switch independently between both network and switch on request by the mobile terminal. Moreover, the system of Cardina does not discuss the ability to switch independently between both network and switch on request by the mobile terminal. In fact, Cardina is incapable of such

ability since the wireless backup device only works when the landline connection is non-functioning. There is no other network or switch that is discussed in Cardina that could be the basis of switching between networks or switches. Thus, there is no reasonable expectation that the system of Cardina would even work with the system of Aretz. MPEP § 2143.02. At the very least, incorporating the system of Aretz into Cardina would impermissibly change the principle of operation of Cardina and/or render Cardina unsatisfactory for its intended purpose. MPEP § 2143.01. Since the stated motivation to combine Cardina and Aretz is not supported by actual evidence, and the proposed combination is also improper because there is no reasonable expectation of success and the combination would impermissibly change the principle of operation of Cardina and/or render Cardina unsatisfactory for its intended purpose, the proposed combination is improper. Accordingly, the rejection is improper and must be withdrawn.

Even if the combination is proper, a point Applicant does not concede, claim 29 depends from claim 1 and therefore contains all of the limitations of claim 1. As set forth above, Cardina does not teach transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network where a temporary directory number is provided during the call. Aretz does not cure the deficiencies of Cardina in this regard. Thus, neither Cardina nor Aretz, alone or in combination, teach or suggest the claimed invention, and claim 29 is allowable for at least the same reasons as claim 1.

Claims 30-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cardina in view of U.S. Patent No. 6,445,921 B1 to Bell (hereinafter “Bell”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Applicant initially notes that the Examiner cited Bell at the top of paragraph 6 on p. 9 of the Final Office Action in rejecting claims 30-32. However, in the body, the Patent Office cites to Aretz. Given that the Patent Office cites to col. 3, line 31 to col. 6, line 58, and that matches with Bell, Applicant presumes that the Patent Office is using Bell and Cardina in the obviousness rejection for claims 30-32.

The Patent Office has not supported the stated motivation to combine Cardina and Bell with actual evidence. The Patent Office indicated it would have been obvious to combine Cardina and Bell “in order to switch independently between both network and switch on request by the mobile terminal.” (Final Office Action mailed August 24, 2006, p. 10). The Patent Office then cites to an advantage of the Aretz system (see Aretz, col. 3, lines 55-63). This is the same

motivation used by the Patent Office for claim 29 to combine Cardina and Aretz. However, the cited advantage of Aretz has nothing to do with Bell and does not support the stated motivation of being able to switch independently between both network and switch on request by the mobile terminal. Since the Patent Office has quoted Aretz, it has not provided any actual evidence to support the stated motivation to combine Cardina and Bell. Since the stated motivation lacks the requisite support, the proposed combination is improper. Since the proposed combination is improper, the rejection is also improper and must be withdrawn.

Even if the combination is proper, a point Applicant does not concede, claims 30-32 depend from claim 1 and therefore contain all of the limitations of claim 1. As set forth above, Cardina does not teach transitioning a call with a dual mode mobile terminal from a wireline network to a wireless network where a temporary directory number is provided during the call. Neither Aretz or Bell cure the deficiencies of Cardina in this regard. Thus, the cited references, alone or in combination, do not teach or suggest the claimed invention, and claims 30-32 are allowable for at least the same reasons as claim 1.

In addition, claims 30-32 have additional limitations. Claim 30 recites detecting the mobile terminal moving out of a wireless communication zone in which communications with the mobile terminal are possible by detecting a degradation in quality associated with communications with the mobile terminal via a local wireless interface surpassing a defined threshold. Claim 31 recites detecting the mobile terminal moving out of a wireless communication zone in which communications with the mobile terminal are possible by detecting an inability to communicate with the mobile terminal via a local wireless interface. Claim 32 recites detecting the mobile terminal moving out of a wireless communication zone in which communications with the mobile terminal are possible by detecting a decrease in signal strength associated with communications with the mobile terminal via a local wireless interface surpassing a defined threshold. Bell does not teach or suggest detecting “a degradation in quality associated with communications with the mobile terminal via a local wireless interface surpassing a defined threshold,” or “an inability to communicate with the mobile terminal via a local wireless interface,” or “a decrease in signal strength associated with communications with the mobile terminal via a local wireless interface surpassing a defined threshold.” Bell merely discloses a dropped call resulting from failure of the cordless first link L₅, for example, due to moving out of range of the cordless base station (see, e.g., Bell, col. 5, lines 24-28). There is no

teaching or suggestion of detecting degradation in quality, an inability to communicate with the mobile terminal, or a decrease in signal strength, as recited in claims 30-32. In fact, Bell specifically teaches away, stating that "there is no need to monitor the strength of signals." (Bell, col. 6, lines 56-57). Since Bell does not teach or suggest detecting degradation in quality, an inability to communicate with the mobile terminal, or a decrease in signal strength, as recited in claims 30-32, and the Patent Office has admitted that Cardina does not teach these elements, the combination of Cardina and Bell does not teach or suggest each and every limitation of claims 30-32. Accordingly, claims 30-32 are patentable for this additional reason.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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